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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,174	09/29/2005	Takatoshi Hirose	00862.023671.	4239
5514 7590 06/23/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER MURRAY, DANIEL C				
ART UNIT		PAPER NUMBER		
2143				
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06/23/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/551,174	HIROSE, TAKATOSHI	
	Examiner	Art Unit	
	DANIEL MURRAY	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29SEP2005.
 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-14 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1 and 3-14 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1) ☒ Certified copies of the priority documents have been received.
 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> | 6) <input type="checkbox"/> Other: _____ |

29NOV2005, 24OCT2006, 11DEC2006, 23MAY2007, 19SEP2007, 25JAN2008, and 06FEB2008

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 10/551174, filed on 29SEP2005.

Information Disclosure Statement

2. The information disclosure statements submitted on 29NOV2005, 24OCT2006, 11DEC2006, 23MAY2007, 19SEP2007, 25JAN2008, and 06FEB2008 have been considered by the Examiner and made of record in the application.
3. Claims 1 and 3-14 are pending. Claim 2 has been canceled by Applicant.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
5. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

6. Claim 3 is objected to because of the following informalities:

- Claim 3 depends on a canceled claim. For the purpose of examination claim 3 will be examined as depending on claim 1.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 12 is rejected by virtue of its dependency on claim 11.

Claim 11 states: A program for causing a computer to execute a method defined in claim 1.

Applicant attempts to claim non-statutory subject matter (i.e. a program). Applicant fails to claim a proper computer readable medium and thus fails to fall within a statutory category and is thus, per se, considered software.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. **Claims 1-3 and 6-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Asoh et al.** (US Patent Publication # US 2004/0003060 A1) in view of **Ohta** (US Patent Publication # US 2001/0029531 A1).

a) Consider claim 1, 10, and 11-12, Asoh et al. clearly show and disclose, a connection control method for an information processing apparatus and information processing apparatus, comprising: a step of receiving identification information for identifying each wireless network out of a plurality of wireless networks (figure 4, figure 10, abstract, paragraph [0012], [0013], [0014], [0014]); a step of wirelessly joining in a wireless network identified by the identification information (figure 4, figure 10, abstract, paragraph [0012], [0013], [0014], [0014]); and a step of joining in another wireless network identified by the other identification information in accordance with the response to the inquiry (figure 4, figure 10, abstract, paragraph [0012], [0013], [0014], [0014], [0020], [0023]). However, Asoh et al. does not specifically disclose a step of inquiring, of other information processing apparatuses in the wirelessly joined wireless network, whether the other information processing apparatuses have a function of performing predetermined processing.

Ohta shows and discloses printing at a convenient location, and more particularly related to a system for and method of printing information at a conveniently located printer station that is selected in a predetermined area, including a step of inquiring, of other information processing

apparatuses in the wirelessly joined wireless network, whether the other information processing apparatuses have a function of performing predetermined processing (abstract, paragraph [0007], [0040]).

Therefore, it would have been obvious to one of ordinary skill in the art that the time the invention was made to incorporate the teachings of Ohta into the system of Asoh et al. for the purpose of locating a print station on a network.

b) Consider **claim 3**, and **as applied to claim 1 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 1, wherein one of the other information processing apparatuses which has first positively responded is controlled to be connected (Ohta; abstract, paragraph [0045]).

c) Consider **claim 6**, and **as applied to claim 1 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 1, wherein in the step of inquiring, the inquiry is performed by a broadcast message for all information output terminals in a single network (Ohta; abstract, paragraph [0045]).

d) Consider **claim 7**, and **as applied to claim 1 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 1, wherein the information processing apparatus wirelessly communicates according to a wireless LAN method defined by IEEE 802.11 (paragraph [0082]).

e) Consider **claim 8**, and **as applied to claim 7 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 7, wherein the information processing apparatus wirelessly communicates in a communication mode according to an infrastructure mode defined by IEEE 802.11 (paragraph [0082]).

f) Consider **claim 9**, and as **applied to claim 7 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 7, wherein the information processing apparatus wirelessly communicates in a communication mode according to an ad-hoc mode defined by IEEE 802.11 (paragraph [0082]).

g) Consider **claim 13**, and as **applied to claim 1 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 1, further comprising, a step of controlling connection to one of the other information processing apparatuses in accordance with a response to the inquiry (Ohta; abstract, paragraph [0007], [0040], [0045]).

h) Consider **claim 14**, and as **applied to claim 13 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 13, wherein in the step of controlling, when the response to the inquiry is a positive response, one of the other information processing apparatuses which has positively responded is controlled to be connected (Ohta; abstract, paragraph [0007], [0040], [0045]).

11. **Claims 4 and 5** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Asoh et al. (US Patent Publication # US 2004/0003060 A1)** in view of **Ohta (US Patent Publication # US 2001/0029531 A1)** and in further view of **Suda et al. (US Patent # 6,157,465)**.

a) Consider **claim 4**, and as **applied to claim 3 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 3. However, Asoh et al. as modified by Ohta does not specifically disclose when the predetermined processing together with the one of the other information processing apparatuses which has first positively responded error ends, another information processing apparatus which has positively responded is controlled to be connected.

Suda et al. show and disclose a printer that is instructed to perform a printing job analyzes the job and determines a process to be executed, and identifies the performances of the printer and other printers and their states. Based on the results of the analysis and on the states of the printers, the printer decides whether it should not perform a process or whether the process should be performed by another printer. It also decides whether a process is unnecessary or is not permitted for a user, and halts the performance of such a process. When it determines that a process should be performed by another printer, it transfers the job to that printer, wherein when the predetermined processing together with the one of the other information processing apparatuses which has first positively responded error ends, another information processing apparatus which has positively responded is controlled to be connected (column 20 lines 41-60, column 21 lines 27-37).

Therefore, it would have been obvious to one of ordinary skill in the art that the time the invention was made to incorporate the teachings of Suda et al. into the system of Asoh et al. as modified by Ohta et al. for the purpose of transferring a job to another device if an error occurs in the device originally executing the job.

b) Consider claim 5, and as applied to claim 1 above, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 1. However, Asoh et al. as modified by Ohta does not specifically disclose when the response to the inquiry is a negative response or no response exists, the information processing apparatus joins in the other wireless network.

Suda et al. show and disclose a printer that is instructed to perform a printing job analyzes the job and determines a process to be executed, and identifies the performances of the printer and other printers and their states. Based on the results of the analysis and on the states of the printers, the printer decides whether it should not perform a process or whether the process should be performed by another printer. It also decides whether a process is unnecessary or is not permitted

for a user, and halts the performance of such a process. When it determines that a process should be performed by another printer, it transfers the job to that printer, wherein when the response to the inquiry is a negative response or no response exists, the information processing apparatus joins in the other wireless network (abstract, column 19 lines 52-64, column 20 lines 41-60).

Therefore, it would have been obvious to one of ordinary skill in the art that the time the invention was made to incorporate the teachings of Suda et al. into the system of Asoh et al. as modified by Ohta et al. for the purpose of locating a device capable of performing a predetermined process.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US 2002/0041388 A1
- US 6,631,008 B2
- US 6,920,506 B2
- US 20070223670 A1
- US 2002/0062407 A1
- 5,687,320
- US 2004/0137855 A1
- WO 01/93514 A1

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL MURRAY whose telephone number is 571-270-1773. The examiner can normally be reached on Monday - Friday 0800-1700 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571)-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daniel Murray/
Examiner, Art Unit 2143

/Nathan J. Flynn/
Supervisory Patent Examiner, Art Unit 2143

Notice of References Cited	Application/Control No. 10/551,174	Applicant(s)/Patent Under Reexamination HIROSE, TAKATOSHI	
	Examiner DANIEL MURRAY	Art Unit 2143	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-2004/0003060 A1	01-2004	Asoh et al.	709/220
*	B	US-2001/0029531 A1	10-2001	Ohta, Yasutoshi	709/223
*	C	US-6,157,465	12-2000	Suda et al.	358/407
*	D	US-2002/0041388 A1	04-2002	AOKI, MIKIO	358/1.14
*	E	US-6,631,008 B2	10-2003	Aoki, Mikio	358/1.15
*	F	US-6,920,506 B2	07-2005	Barnard et al.	709/245
*	G	US-2007/0223670 A1	09-2007	Ido, Tetsuo	379/201.01
*	H	US-2002/0062407 A1	05-2002	Tateyama et al.	710/11
*	I	US-5,687,320	11-1997	Wiley et al.	709/245
*	J	US-2004/0137855 a1	07-2004	Wiley et al.	455/088
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N	WO 01/93514 A1	12-2001	Sweden	Fritz et al.	
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)			
	U				
	V				
	W				
	X				

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.